



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/551,660

11/29/2006

Patrick E. Snow

**RC-0012

4599

23623 7590 04/01/2011
TUROCY & WATSON, LLP
127 Public Square
57th Floor, Key Tower
CLEVELAND, OH 44114

EXAMINER

KHAN, MEHMOOD B

ART UNIT

PAPER NUMBER

2617

NOTIFICATION DATE

DELIVERY MODE

04/01/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket1@thepatentattorneys.com
hholmes@thepatentattorneys.com
setoori@thepatentattorneys.com

Office Action Summary	Application No. 10/551,660	Applicant(s) SNOW, PATRICK E.	
	Examiner MEHMOOD B. KHAN	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24,26,33,35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24,26,33,35 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 01/05/2011 have been fully considered but they are not persuasive. Applicant argues that O'Neil does not teach the amended limitation of "wherein a size of the specific geographic region changes in response to a change in a location of the second portable digital device".

The Examiner respectfully disagrees. Please see the discussion below with respect to the amended limitation and how O'Neil has reads on the limitation.

Please note that applicant has amended heavily and has changed scope the claims. Thus the rejection of the claims has also changed. Please see the discussion below

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 35 recites "tangible computer-readable medium" which is not found in the specification. The original claims are considered part of the specification and can be copied into the specification to provide for proper antecedent basis.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 26, 35 and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

Art Unit: 2617

claimed invention. The amendment to the claims, specifically “wherein a size of the specific geographic region changes in response to a change in a location of the second portable digital device” is nowhere to be found in the submitted specification. Thus constituting new matter.

Claims 1, 26, 35 and 37 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The amended claim recites the limitation, as stated above, which is/are not recited or stated in the originally submitted specification and thus does not enable one of ordinary skill in the art to determine the scope of the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 14, 15, 18, 21, 22, 35, 37 are rejected under 35 U.S.C. 102(e) as being anticipated by O’Neil (US 6,973,333).

Claim 1, O’Neil discloses determining based on comparison of geographic coordinates whether a first portable digital device (**Col 8: 10-15, cell phone**) is within a specific geographic region around a second portable digital device (**Col 14: 12-18, Col 8: 10-15, Fig. 5: Regions Table, where O’Neil discloses determining GPS location of the vehicle, i.e. second portable device, comparing with region information of the cell phone**),

Art Unit: 2617

wherein a size the specific geographic region changes in response to a change in location of the second portable digital device (**Col 14: 7-22, vehicle location is derived from on board GPS and compared with regions, Col 8: 10-15, 55-65, Col 8: 30-36, The shape and size of the region will vary from one location to another, Col 8: 37-47, use of a cell phone while in all applicable regions**); and

O'Neil discloses inhibiting an operation of the first portable digital device upon receipt of a first inhibiting signal transmitted by the second portable digital device (**Col 13: 40-45, where O'Neil discloses imposing prohibitions on identified cell phones by using command messages, i.e. a first inhibiting signal**), O'Neil discloses the first portable digital device is located in the specific geographic region around the second portable digital device (**Col 14: 12-18, where O'Neil discloses comparison of GPS with region ID provided by the cell phone**).

Claim 14, O'Neil discloses accessing usage control code on the first portable digital device for controlling usage of the first portable digital device (**Fig. 4: 470, where O'Neil discloses restrictions table**).

Claim 15, as analyzed with respect to the limitations as discussed in claim 14.

Claim 18, Claim 18 further limits an alternative of claim 1. Since O'Neil discloses the "audio function", the limitations of claim 18 have been met.

Claim 21, O'Neil discloses a step of broadcasting a source-identifying signal to the specific geographical region (**Col 4: 59-61, where O'Neil discloses identified locations**).

Claim 22, O'Neil discloses wherein the source-identifying signal comprises one of an audio tone or a series of optical signals (**Col 15: 40-45, where O'Neil discloses infra red**).

Claim 35, as analyzed with respect to the limitations as discussed in claim 1.

Claim 37, as analyzed with respect to the limitations as discussed in claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5, 6, 8, 9-12, are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil (US 6,973,333) in view of Watanabe et al. (US 2005/0285944 herein Watanabe).

Claim 2, O'Neil discloses receiving a second inhibiting signal from a fixed location security station in the specific geographic region (**Col 6: 30-45, where O'Neil discloses applicability of restrictions from a CRS (Fig. 3: 330), i.e. fixed station, based on location).**

O'Neil does not explicitly disclose disabling the [[at least one of audio and]] image data recording function of the portable digital device in response to receipt of the inhibiting signal.

In an analogous art, Watanabe discloses disabling the [[at least one of audio and]] image data recording function of the portable digital device in response to receipt of the [[first or]] inhibiting signal (**0049, where Watanabe discloses prohibiting image capturing).**

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Neil prohibit image capture as taught by Watanabe so as to prohibit people from taking flash photography in restricted areas (**0007).**

Claim 3, O'Neil discloses enabling at least one of an audio data recording function or an image data recording function in response to the first portable digital device being located

Art Unit: 2617

outside the specific geographic **(Col 14: 12-18, where O'Neil discloses comparing the GPS position to enact restrictions, so thus when no match of region ID and GPS, hence no restriction).**

O'Neil does not explicitly disclose when said device is outside the specific geographic region, an image data recording function is functional **(0048, 0049, where Watanabe discloses restriction/prohibition within range of Wireless Communication, so thus when outside the range image capture is functional).** Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Neil prohibit image capture as taught by Watanabe so as to prohibit people from taking flash photography in restricted areas **(0007).**

Claim 5, as analyzed with respect to the limitations as discussed in claim 2.

Claim 6, O'Neil discloses determining the geographic region of the first portable digital device using a navigation module selected from the group: GPS, GSM, GPRS, MA, UTMS and 3G **(Col 3: 10-15, where O'Neil discloses obtaining GPS location of the phone, Col 14: 12-18, where O'Neil discloses comparison of GPS with region ID provided by the cell phone).**

Claim 8, O'Neil discloses storing data relating to said device detected as being present in the specific geographical region **(Col 8: 55-57, where O'Neil discloses storing region IDs).**

Claim 9, O'Neil discloses inhibiting the operation for at least a predetermined period of time **(Col 15: 10-15, where O'Neil discloses restricting operation for a predetermined time).**

Art Unit: 2617

Claim 10, O'Neil discloses modifying a memory of the first portable digital device to indicate that the inhibiting of the operation has occurred (**Fig. 10, where O'Neil discloses active warning = true**), O'Neil discloses checking whether the memory has been modified to indicate that the inhibiting of the operation has occurred before allowing access to function (**Fig. 11, where O'Neil discloses active warning = false and not blocking calls**).

O'Neil does not explicitly disclose the data recording function.

In an analogous art, Watanabe discloses the data recording function (**0049**). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Neil to prohibit image capture as taught by Watanabe so as to prohibit flash photography in restricted areas (**0007**).

Claim 11, O'Neil discloses wherein receiving the first inhibiting signal at the first portable digital device using a communication scheme transmitting-over at least one radio frequency (**Fig. 1: 125, where O'Neil discloses a cellular base station, thus cellular frequencies and a communication scheme**).

Claim 12, O'Neil discloses changing a frequency of the at least one radio frequency at an interval (**Fig. 21, where O'Neil discloses periodic warning**).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable O'Neil in view of Watanabe in view of Heiskari et al. (US 5,901,342 herein Heiskari).

O'Neil discloses the second inhibiting signal (**see claim 1**).

O'Neil does not explicitly disclose wherein at least one portable device is used as a repeater to broaden coverage.

Art Unit: 2617

In an analogous art, Heiskari discloses at least one portable device is used as a repeater to broaden coverage (**Col 4: 64-64, where discloses using phones as repeaters**). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Neil in view of Watanabe to include using phones as repeaters as taught by Heiskari so as to transmission at fixed states (**Col 2: 60**).

Claim 24, as analyzed with respect to the limitations as discussed in claim 4.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil in view of Watanabe in view of Fomukong (US 2008/0051105).

O'Neil does not explicitly disclose wherein the geographic location of the device is monitored by triangulation of signals from at least two cellular base stations.

In an analogous art, Fomukong discloses wherein the geographic location of the device is monitored by triangulation of signals from at least two cellular base stations (**0028, where Fomukong discloses earth based stations**). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Neil to include monitoring of mobile phones as taught by Fomukong so as to providing secured and accessible remote receiving unit position information (**0005**).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil in view of Cho (EP 1139684).

O'Neil discloses wherein the first inhibiting signal is communicated to the first portable digital device in the form of [[one of an audio signal or]] a signal transmitted using short-range transmitters (**Col 7: 6-10, Col 13: 45-50, where O'Neil discloses short-range transmission, i.e. BLUETOOTH**).

O'Neil does not explicitly disclose an inhibiting signal transmitted at an optical frequency.

Art Unit: 2617

In an analogous art, Cho discloses an inhibiting signal transmitted at an optical frequency **(0048, where Cho discloses acoustic and infra red waves)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Neil to inhibit devices as taught by Cho so as to provide protection of observed secrets **(0006)**.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil in view of Aerrabotu (US 6,829,429).

O'Neil does not explicitly disclose a step of modifying code within the device relating to the at least one of audio recording function and an image data recording function and preventing said code being executed by the device.

In an analogous art, Aerrabotu discloses a step of modifying code within the device preventing said code being executed by the device **(Claim 9)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Neil to include modifying code as taught by Aerrabotu so as to provide an improved and convenient method for releasing service locks **(Col 1: 44-45)**.

Claims 17, 19, are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil in view of Watanabe in view of Cocita (US 2006/0281450).

Claim 17, O'Neil discloses detecting disconnection of the device from a communications network **(Fig. 13: 1340, where a region ID is checked before applying restrictions, thus leaving an area)**.

O'Neil in view of Watanabe does not explicitly disclose preventing a normal transmission operation relating to captured data upon said disconnection.

In an analogous art, Cocita discloses preventing a normal transmission operation relating to captured data **(0026, where Cocita discloses that is well known to delete data)**.

Art Unit: 2617

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Neil in view Watanabe to include erasing data as taught by Cocita so as to provide safeguarding data **(0009)**.

Claim 19, O'Neil in view Watanabe does not explicitly disclose deleting the captured data from the device.

In an analogous art, Cocita discloses deleting the captured data from the device **(0019, where Cocita discloses erasing all data)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Neil in view Watanabe to include erasing data as taught by Cocita so as to provide safeguarding data **(0009)**.

Claims 20, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil in view of Hirai.

Claim 20, O'Neil in view Watanabe in view of Cocita does not explicitly disclose transmitting the captured data relating to the first portable digital device to a security entity.

In an analogous art, Hirai discloses transmitting the captured data relating to the device to a security entity **(Fig. 3A, where Hirai discloses transmission to the monitoring station)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Neil in view Watanabe in view of Cocita to include transmission to a monitor as taught by Hirai so as to copyright protection.

Claim 23, O'Neil does not explicitly disclose checking if data transmitted over a network includes a recording of the source-identifying signal, and transmitting the data to a security entity instead of its intended recipient.

In an analogous art, Hirai discloses checking if data transmitted over a network includes a recording of the source-identifying signal, and transmitting the data to a security entity instead

Art Unit: 2617

of its intended recipient (**Fig. 3A**). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Neil to include transmission to a monitor as taught by Hirai so as to provide copyright protection.

Claim 26, as analyzed with respect to the limitations as discussed in claim 1.

O'Neil does not explicitly disclose preventing the attempted transmission of data including the source-identifying signal.

In an analogous art, Hirai discloses preventing the attempted transmission of data including the source-identifying signal (**Fig. 3A, where Hirai discloses transmission to a monitoring station**). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Neil to include transmission to a monitor as taught by Hirai so as to provide copyright protection.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cho in view of Hirai.

Cho discloses enabling operation of said imaging function in response to an interrogation or enabling signal from a central station (**0033, where Cho discloses leaving the area**).

Cho does not explicitly discloses returning an image to said central station (**Fig. 3A, where Hirai discloses transmission to a monitoring station**). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cho to include transmission to a monitor as taught by Hirai so as to provide copyright protection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to

Art Unit: 2617

expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MEHMOOD B. KHAN whose telephone number is (571)272-9277. The examiner can normally be reached on Monday - Friday 8:30 am - 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. B. K./
Examiner, Art Unit 2617

/Lester Kincaid/
Supervisory Patent Examiner, Art Unit 2617